

REMARKS

The Examiner's Answer¹ sets forth a new ground of rejection of claims 2-6, 8-17, and 19-44 under 35 U.S.C. § 101.

In addition, the following claims stand rejected:

A. Claims 2-6, 8-17, 19-27, 32, 38, 39, and 41-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 2001104050 to Nagaishi ("Nagaishi") in view of U.S. Patent Application Publication No. 20010037191 to Furuta et al. ("Furuta");

B. Claims 28-31 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagaishi in view of Furuta and further in view of Nobori et al., *Image Synthesis System Using 3D Model-based Coding Simulates Facial Expressions and Aging*, IEEE, 1992, pages 394-395 ("Nobori");

C. Claims 33-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagaishi in view of Furuta and further in view of U.S. Patent No. 6,504,546 to Cosatto ("Cosatto"); and

D. Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagaishi in view of Furuta, in view of Cosatto, and further in view of U.S. Patent Application Publication No. 20030164955 to Vinas et al. ("Vinas").

¹ The Examiner's Answer contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Examiner's Answer.

By this Reply, Applicants have amended claims 2-5, 8, 11-17, 19-21, 25-28, 32, 33, 36-38, 40, 41, 43, and 44, canceled claims 6, 9, 10, 22-24, 35, and 39 without prejudice or disclaimer, and added new claims 45-52. The subject matter of canceled claim 6 has been incorporated into amended independent claim 20. Support for the amendments and new claims can be found throughout the specification, for example, at page 9, lines 9-17; page 10, lines 22-26; page 16, lines 3-18; page 19, lines 6-17; page 20, lines 1-18; page 21, line 7 - page 23, line 18; page 33, line 3 - page 34, line 22; page 40, line 1 - page 43, line 20; page 48, lines 1-12. Claims 1, 7, and 18 were previously canceled without prejudice or disclaimer. Claims 2-5, 8, 11-17, 19-21, 25-34, 36-38, and 40-52 are currently pending, with claims 20, 26, and 27 being independent. Based on the foregoing amendments and the following remarks, Applicants respectfully traverse the rejections.

I. New Ground of Rejection of Claims 2-6, 8-17, and 19-44 Under 35 U.S.C. § 101

The Examiner's Answer rejects claims 2-6, 8-17, and 19-44 based on a new ground of rejection under 35 U.S.C. § 101 because "Applicant [purportedly] has provided no explicit and deliberate definitions of 'facilitating construction,' 'facilitating processing,' 'analyzing,' or 'proposing' to limit the steps to an electronic form of the 'enabling analysis' and the claim language itself is sufficiently broad to read on a person carrying out the steps of the beauty analysis in their head." Examiner's Answer at 4.

Although Applicants believe the claims recite statutory subject matter, Applicants have amended claims 2-5, 8, 11-17, 19-21, 25, 28, 32, 33, 36-38, 40, 41, 43, and 44 to

include certain additional recitations, such as, e.g., “providing a computer system . . .” (claim 20). Claims 2-5, 8, 11-17, 19, 21, 25, 28-34, 36-38, and 40-44 depend from amended independent claim 20. Thus, amended independent claim 20 and dependent claims 2-5, 8, 11-17, 19, 21, 25, 28-34, 36-38, and 40-44 are tied to a particular machine, and conform with the Federal Circuit decision in *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 2-5, 8, 11-17, 19-21, 25, 28-34, 36-38, and 40-44.

In addition, Applicants have amended claims 26 and 27 into an independent form. Amended independent claim 26 recites “[a] computer-readable medium containing instructions for causing a computer to perform . . . ,” and amended independent claim 27 recites “[a] computer system for use in analyzing an external body condition using a three-dimensional facial image.” Thus, amended independent claims 26 and 27 are tied to a particular machine, and recite statutory subject matter. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 26 and 27.

II. The Rejection of Claims 2-6, 8-17, 19-27, 32, 38, 39, and 41-44 Under 35 U.S.C. § 103(a) Based on Nagaishi and Furuta

The rejection of claims 2-6, 8-17, 19-27, 32, 38, 39, and 41-44 under 35 U.S.C. § 103(a) based on Nagaishi and Furuta should be withdrawn because a *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A. Claim 20

Amended independent claim 20 recites, among other features, “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and

“displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image.” Nagaishi and Furuta, taken alone or in combination, fail to teach or suggest the recited subject matter.

As the Examiner correctly observed, Nagaishi does not teach or suggest “us[ing] a three-dimensional facial image.” Examiner’s Answer at 5. Thus, although Nagaishi discloses “extracting [a] face image from [an] image obtained by [a] camera [and] analyzing the face image,” the reference does not teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional image,” as recited in claim 20 (emphasis added), see also Nagaishi, Abstract. As the Examiner noted, “there is a problem with prior art systems in which the two dimensional image processing did not appear realistic.” Examiner’s Answer at 6. As the Examiner acknowledged and would agree, analyzing a two-dimensional image would be based on images that do not appear realistic and thus would not provide accurate assessment of skin conditions.

The Examiner asserted that Nagaishi “provides all the requisite equipment in order to make the system three-dimensional” because “[i]n paragraph 0034 of Naigaishi it is [allegedly] disclosed that two cameras can be installed on both sides of the user and that the images from both cameras can be mixed to get the front face image for a person.” Id. Applicants respectfully disagree. First, Nagaishi discloses that “a camera can be installed in two mirrors,” and does not disclose that “two cameras can be installed on both sides of the user . . . ,” as alleged by the Examiner. Nagaishi, paragraph [0034]. In addition, even assuming, *arguendo*, that Nagaishi discloses “a plurality of images taken from different directions,” as alleged by the Examiner,

Nagaishi's disclosed approach still involves "analyzing [a plurality of two-dimensional] face image[s]" that are "obtained by camera[s]." Examiner's Answer at 6; Nagaishi, Abstract.

In addition, Nagaishi does not teach or suggest "displaying . . . simulated effect of the beauty product on the external body condition via the three-dimensional facial image," as recited in amended independent claim 20. The Examiner asserted that Nagaishi teaches that "advice is given as to the makeup for the subject to wear [0013] and this indicates which cosmetics are best for the user together with its usage which can be displayed [0019]." Examiner's Answer at 5. Even assuming, *arguendo*, that the assertion were true, which Applicants dispute, Nagaishi fails to teach or suggest "displaying, on a display device, simulated effect of the beauty product on the external body condition via the three-dimensional facial image," as recited in amended independent claim 20. Paragraph [0013] of Nagaishi generally discusses generating contents of advice about optimal cosmetic, and paragraph [0019] of Nagaishi generally discusses presenting the user with *information* related to an optimal cosmetic and use of the cosmetic. Nothing in paragraphs [0013] and [0019], however, discloses or suggests "simulat[ing] effect of [a] beauty product on [an] external body condition," not to mention "via [a] three-dimensional facial image," as recited in amended independent claim 20.

Furuta fails to cure the deficiencies of Nagaishi. The Examiner asserted that Furuta discloses performing "simulations of makeup, cosmetic surgery, clothing, perfume, accessories, hair style, etc. based on 3D information." Examiner's Answer

at 5. However, performing simulations on a 3D model, as disclosed by Furuta, does not constitute “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” as recited in claim 20. In other words, mere disclosure of simulation in 3D adds nothing to the disclosure of Nagaishi to make the analysis of an external body condition possible via a three-dimensional facial image. Simulating a 3D image and analyzing an external body condition via a three-dimensional image require different skills and techniques, and thus, simulation based on a 3D model disclosed in Furuta does not cure the deficiencies of Nagaishi.

Moreover, Furuta discloses makeup simulations based on makeup styles and techniques, but not based on a beauty product. For example, Furuta discloses that “[a] makeup style corresponding to various types of situations may be prepared in advance, such as party makeup, work makeup, etc., and the consumers face may be reproduced with the new makeup style based on a single touch of the touch panel.” Furuta at paragraph [0038]. Furuta also discloses that “a makeup technique is deduced from the ideal makeup face. In other words, a series of makeup pointers by which to obtain the desired look, such as the areas where the eyebrows should be plucked or darkened, lines and areas where eye liner or eye shadow should be applied, eye shadow colors, areas where lipstick should be applied, and techniques for the application of foundation, are determined based on a preset markup program.” Furuta at paragraph [0053]. Although Furuta teaches simulating makeup styles or techniques, it does not teach or suggest “simulat[ing] effect of [a] beauty product on [an] external body condition,” as recited in amended independent claim 20.

In view of the above-noted deficiencies of the Nagaishi and Furuta references, the Examiner's Answer has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 20. Also in view of those deficiencies, no combination of the applied references can possibly yield the invention of claim 20, nor could the invention of claim 20 have been predictable from the applied references. Further in view of those deficiencies, there would have been no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve the claimed combinations. Thus, the Examiner's Answer has failed to clearly articulate a reason why claim 20 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 20 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

In the Examiner's Answer at 17, the Examiner asserted that "the recent board decision of *KSR* . . . forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness" (citing *Ex parte Smith*, Bd. Pat. App. & Inter. June 25, 2007).

The Supreme Court in *KSR* emphasized that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Federal Circuit has also stated that, even after the Supreme Court's decision in *KSR*, "a flexible [teaching, suggestion, and motivation] test remains the primary guarantor against a non-statutory hindsight analysis." *Ortho-McNeil Pharm.*,

Inc. v. Mylan Labs., Inc., 520 F.3d 1358, 1364 (Fed. Cir. 2008). Neither *KSR* nor *Ex parte Smith* lifts the Examiner's burden of establishing a *prima facie* case of obviousness.

Applicants respectfully submit that an improper reliance on *KSR*, especially in combination with a disregard of the burden of establishing a *prima facie* case of obviousness, is clearly erroneous. The Examiner asserted that “[t]he difference between Naigaishi and Furuta is that Naigaishi uses two-dimensional images whereas Furuta discloses three-dimensional images.” Examiner’s Answer at 7. This oversimplification of the technologies clearly shows the failure to properly determine, at least, among other things, the scope and content of the prior art, which is required even in the Board decision that the Examiner cites. See *Ex parte Smith* at 12 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). As explained above, the system of Nagaishi is not a simulation system but rather a system that “analyz[es] [a] face image, generate[s] . . . advice related to the makeup for [a] person to wear[, and] present[s] the information [in] output form,” and differs significantly from the simulation system of Furuta. Nagaishi, Abstract (emphasis added).

For these additional reasons, a *prima facie* case of obviousness has not been established with respect to claim 20 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

B. Claims 26 and 27

Although of different scope, amended independent claims 26 and 27 recite features that are similar to the features recited in amended independent claim 20. For

example, amended independent claims 26 and 27 recite, among other things, “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image.” As explained above with respect to amended independent claim 20, a *prima facie* case of obviousness has not been established with respect to claims 26 and 27 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

C. Claims 2-5, 8, 11-17, 19, 21, 25, 32, 38, and 41-44

Claims 2-5, 8, 11-17, 19, 21, 25, 32, 38, and 41-44 depend from amended independent claim 20. Dependent claims 2-5, 8, 11-17, 19, 21, 25, 32, 38, and 41-44 are thus allowable at least by virtue of their dependence from an allowable independent claim.

III. The Rejection of Claims 28-31 and 40 Under 35 U.S.C. § 103(a) Based on Nagaishi, Furuta, and Nobori

Dependent claims 28-31 and 40 depend from amended independent claim 20. As explained above with respect to claim 20, Nagaishi and Furuta, taken alone or in combination, fail to teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

Nobori fails to cure the deficiencies of Nagaishi and Furuta. Nobori allegedly “discloses a fitting algorithm using a polygonal wireframe model to obtain a synthesized

3d face model (section 2).” Examiner’s Answer at 11. Even if the allegation were true, Nobori fails to teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

For at least these reasons, Nagaishi, Furuta, and Nobori, fail to support the § 103(a) rejection of claim 20. Dependent claims 28-31 and 40 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 28-31 and 40 based on Nagaishi, Furuta, and Nobori.

IV. The Rejection of Claims 33-36 Under 35 U.S.C. § 103(a) Based on Nagaishi, Furuta, and Cosatto

Dependent claims 33, 34, and 36 depend from amended independent claim 20. As explained above with respect to claim 20, Nagaishi and Furuta, taken alone or in combination, fail to teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

Cosatto fails to cure the deficiencies of Nagaishi and Furuta. Cosatto allegedly “discloses a method for modeling three-dimensional objects wherein using color calibration periodically the appearances of facial features can be tracked.” Examiner’s Answer at 12. Even if the allegation were true, Cosatto fails to teach or suggest

“analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

For at least these reasons, Nagaishi, Furuta, and Cosatto, fail to support the § 103(a) rejection of amended independent claim 20. Dependent claims 33, 34, and 36 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 33, 34, and 36 based on Nagaishi, Furuta, and Cosatto.

V. The Rejection of Claim 37 Under 35 U.S.C. § 103(a) Based on Nagaishi, Furuta, Cosatto, and Vinas

Dependent claim 37 depends from amended independent claim 20. As explained above with respect to claims 33-36, Nagaishi, Furuta, and Cosatto, taken alone or in combination, fail to teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and “displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

Vinas fails to cure the deficiencies of Nagaishi, Furuta, and Cosatto. Vinas allegedly “discloses that if a user is very sensitive to color issues then he may manually [initiate] a color calibration process at any time (paragraph 46).” Examiner’s Answer at 13. Even if the allegations were true, Vinas fails to teach or suggest “analyzing . . . at least one external body condition via [a] three-dimensional facial image,” and

“displaying . . . simulated effect of [a] beauty product on the external body condition via the three-dimensional facial image,” as recited in amended independent claim 20.

For at least these reasons, Nagaishi, Furuta, Cosatto, and Vinas, taken alone or in combination, fail to support the § 103(a) rejection of claim 20. Dependent claim 37 is allowable at least by virtue of its dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 37 based on Nagaishi, Furuta, Cosatto, and Vinas.

VI. New Claims 45-52

New claims 45-52 depend from amended independent claim 20. New claims 45-52 are allowable at least by virtue of their dependence from an allowable independent claim. In addition, new claims 45-52 recite further distinctions over the cited references. Accordingly, Applicants respectfully request that new claims 45-52 be allowed.

VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 23, 2009

By:

A handwritten signature in black ink, appearing to read 'Anthony M. Gutowski', is written over a horizontal line.

Anthony M. Gutowski
Reg. No. 38,742
(202) 408-4000